SUPREME COURT, U. S.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1973.

No. 73-1142

SILVESTRI CORPORATION,

Petitioner,

vs.

MARSHALL FIELD & CO., J. C. PENNEY CO., INC. AND CO-OP ELECTRIC SUPPLY CO.,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Petitioner, Silvestri Corporation, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit entered November 16, 1973, and the order of said Court denying plaintiff-appellee's petition for rehearing entered December 20, 1973.

I.

OPINIONS BELOW.

The Opinion of the Court of Appeals is unreported and appears in the Appendix to this Petition, commencing at page A1. The Order of the Court of Appeals denying plaintiff-appellee's

petition for rehearing and suggestion that the rehearing be *en banc* appears in the Appendix hereto, commencing at page A7.

The Findings of Fact and Conclusions of Law entered by the United States District Court for the Northern District of Illinois, Eastern Division, which are also unreported, appear in the Appendix hereto, commencing at page A8.

II.

JURISDICTION OF THIS COURT.

Jurisdiction of this Court is invoked under 28 United States Code, Section 1254(1).

III.

QUESTIONS PRESENTED FOR REVIEW.

1. Does the three-step decisional process mandated by this Honorable Court in *Graham* v. *John Deere Co.* require consideration in every case of the so-called "subtests" of nonobviousness, and the weighing of all the relevant facts in the record that shed light on the question of nonobviousness? Or can the evidence of the subtests be ignored in any case in which the trial court has an initial subjective feeling that—regardless of what those skilled in the art have in fact done—the invention in question *should* have been obvious to such persons at the time it was made?

2. Should the term "equivalents" in Section 112 of the Patent Act of 1952 be given a narrower meaning than the same term is given in connection with the equitable doctrine of equivalents enunciated by this Honorable Court more than a century ago?

IV.

CONSTITUTIONAL PROVISION AND STATUTE INVOLVED.

The Constitutional provision and statute involved in this petition are:

1. CONSTITUTION OF THE UNITED STATES, Article I, Section 8:

"The Congress shall have Power * * *

"To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; * * *"

2. THE PATENT ACT OF 1952, 35 United States Code, Section 103:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *"

3. THE PATENT ACT OF 1952, 35 United States Code, Section 112, last paragraph:

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

V.

STATEMENT OF THE CASE.

This lawsuit was brought by petitioner's predecessor in interest against three companies who sell a whirlpool bath unit for home use that petitioner charges infringes five claims of Patent

No. 3,292,615.* The District Court held the patent in suit invalid and, even if valid, not infringed. The Court of Appeals affirmed.

Holding of Invalidity.

The basis for the holding of invalidity by the District Court was that "the subject matter of the claims as a whole would have been obvious at the time of the alleged invention by one skilled in the mechanical and electrical appliance art" (Finding of Fact 26, App. 18). The District Court reached this conclusion as to "obviousness" because of its initial subjective feeling that—regardless of what those skilled in the art had in fact done—the invention in question *should* have been obvious to skilled workers in the art at the time it was made. Thus, in its Finding of Fact 28 (App. 19), the Court rejected all evidence relating to the so-called "subtests" of nonobviousness, saying:

> "28. Under the circumstances of this case, it is unnecessary to consider the subtests of non-obviousness, such as long-felt need, commercial success, etc., because it is clear from the prior art that the patent in suit would have been obvious to a person having ordinary skill in the art."

Based on this finding, the District Court refused to consider the following uncontroverted evidence, which is clearly relevant to the question of the "nonobviousness" of the patented invention:

1. At the time the invention of the patent in suit was made, there was a long established recognition of the importance of

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* "Device for Agitating, Swirling and Aerating the Water in a Vessel, Such as a Bath Tub or the Like," issued December 20, 1966 (PX-1, Ex. Vol. 1). The patent was assigned on its face to Boulevard Electronics, Inc., and is now owned by Silvestri Corporation.

The symbols listed below are used in this petition as indicated:

Tr.	Transcript
App.	Joint Appendix (Volume I)
Ex. Vol.	Exhibit Volume (Volume II)
PX	Plaintiff's Exhibit
Dep.	Deposition

whirlpool bath treatment (PX-3 to 5, PX-55, Ex. Vol. 6-9, 49 and Tr. 146-149, 153, 158, App. 54-57), and a long-felt need to improve portable whirlpool bath units for home use, particularly with regard to the degree of convenience and safety offered by such devices (*e.g.*, PX-73, Ex. Vol. 85-89, col. 1, lines 29-31 and Tr. 280-288, 442-443, App. 59-64, 179).

2. As pointed out by petitioner in its briefs below—and nowhere denied by respondents—the device covered by the claims of the patent in suit avoided *all* the disadvantages of the prior art HANDI-WHIRL unit, the prior art device on which the respondents and the District Court placed greatest reliance.

3. The patented device has important advantages of convenience and safety when compared to all other prior art whirlpool bath units, including the HYDRO-BATH and AQUA-SPA units which were relied on most heavily, together with the HANDI-WHIRL unit, by the Court of Appeals (Tr. 66-68, 72-77, 96-97, 114-121, 319-323, 441-442, App. 32-35, 37, 42-44, 70-72, 178-179).

4. Despite the undisputed advantages of the patented device, *all* workers in this field failed to conceive of this idea until Mr. and Mrs. Bascomb (to whom the patent in suit was granted) made their invention.

5. In particular, this included Samuel L. McNair—a skilled worker in the field characterized by one of the owners of the company that makes the accused device as "one of the top men in this country," "one of the most capable men in America," and a "genius" in his field (Talge Dep. 5, 7, App. 201, 203)—who worked *for over four years* to develop an improved home whirlpool bath unit,* yet did not develop the accused device until more than a year *after* plaintiff began to advertise its patented device nationally (Tr. 105, 108-113, App. 38-42; PX 20-25, 27-30, 32-36, Ex. Vol. 20-35).

* McNair testified that "*from 1960 on*, we would come up with different ideas on whirlpool baths, both ones that could be used in the bath tubs and others that could be used for health clubs, et

Holding of Noninfringement.

In affirming the District Court holding of noninfringement, the Court of Appeals considered it significant that there is a "*single* adjustable brace rod on the exterior" of the tub in the illustrative embodiment disclosed in the patent in suit, while there are *two* "adjustable slide members on the outside" of the tub in the accused device (page A6, below). The Court also contrasted "the *flat surface of the housing* on the inside of the tub" in the patent's illustrative embodiment with the "movable, flexible, *adjustable plate* in the accused device, which is on the inside of the tub" (page A6, below).

For the two reasons indicated, the Court of Appeals concluded that the stabilizing means in the accused device was not the "equivalent" (within the meaning of Section 112 of the Patent Act of 1952) of the specific stabilizing means illustratively disclosed in the patent in suit. Thus, the Court concluded that the accused device does not infringe the patent in suit.

VI.

REASONS FOR GRANTING THE WRIT.

Question 1.

The decision of the Court of Appeals for the Seventh Circuit on the first question presented for review here is in direct conflict with the purpose of the doctrine enunciated by this Court

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cetera." He further testified that beginning in the middle of 1964, he started what he characterized as *"really substantial"* work "on a whirlpool bath to update it to see if we could make it better." At that time, he said, "we approached it in a number of ways," and it was then that "we really seriously got down to it . . . to consider one ready to put together for production." He finally completed a rough mock-up of the accused device in the middle of December 1964. (McNair Dep. 12-13, 23, App. 190, 192-193; Tr. 196-197, 228, 245-246, App. 147, 164-165, 168.) Tom Kellogg, an industrial designer, developed a housing and stabilizing means for the device in the next month or so thereafter (McNair Dep. 23, App. 192-193; Tr. 189-199, App. 143-149).

in *Graham* v. *John Deere Co.*, 383 U. S. 1, 15 L. Ed. 2d 545 (1966). If that conflict is not clear from the decision of this Court in *Graham*, then it is respectfully submitted this very important question should be settled once and for all by this Honorable Court.

(a) Decision Below Defeated This Court's Graham Goals of Uniformity and Definiteness.

To apply the doctrine of the *Graham* case in the way the District Court and Court of Appeals did here is to make the doctrine of that landmark case nothing but a sham. For if the *objective, pragmatic evidence* of what skilled workers in the field have actually done can be ignored in favor of the *initial subjective reaction* of a single judge (or even three reviewing judges), then one of the most important objectives of this Court in its *Graham* decision—to achieve *uniformity* and *definiteness* in the decision of questions of "obviousness"—will be undermined and defeated.

It was eight years ago that this Court held that the standard of invention to be applied to determine the validity of a patent had been codified by Section 103 of the Patent Act of 1952 in the concept of "nonobviousness," which took the place of the "less definite" term "invention" (383 U. S. at 14) that had grown to be widely used in the more than one hundred years since the decision in *Hotchkiss* v. *Greenwood*, 52 U. S. (11 How.) 248, 13 L. Ed. 683 (1851). The Court then outlined the oft-quoted three-step procedure that must be followed by a court in passing upon the question of nonobviousness (383 U. S. at 17):

> "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined."

The purpose of requiring the courts to follow this decisional process was clear. It was *not* to require an empty, meaningless procedure that would provide no greater uniformity or definiteness than had been the case under the *Hotchkiss* rule. The purpose was to make the determination of nonobviousness a "*functional*" decision (383 U. S. at 12), based as much as possible on objective evidence resulting from "*factual* inquiries" (383 U. S. at 17) made in a "*factual* context" (383 U. S. at 18).* The express goal was to bring out "more *stability* and *predictability* in determining patentability and validity" (383 U. S. at 16), thus assuring achievement insofar as possible of "that *uniformity* and *definiteness* which Congress called for in the 1952 Act" (383 U. S. at 15, 18).

By ignoring the uncontroverted *factual* evidence relating to (i) the longfelt need for a solution to the problem to which the patent in suit is addressed, (ii) the important advantages provided by the patented device as compared to prior art devices, (iii) the continued failure of others skilled in the art to solve that problem, and (iv) specifically, the failure of Samuel L. McNair (a "genius" in this field), the Courts below have defeated the purpose of the *Graham* doctrine.

(b) Judicial Decisions Regarding "Nonobviousness" Should Be Based on As Much Relevant Factual Evidence As Possible.

This Court recognized in its *Graham* decision that there would be "difficulties in applying the nonobviousness test," and there was not "likely to be uniformity of thought in every given factual context" as to what was and what was not "obvious" (383 U. S. 18).** But it did make one thing very plain: A court is

* Unless otherwise indicated, emphasis in this brief is supplied.

** Complete uniformity in court decisions regarding "nonobviousness" would of course never be possible, since the subjective judgment factor can never be totally eliminated from the decisional process. Nevertheless, the extent of subjective variations from one judge to another should be at least minimized by enlarging the scope of the objective facts that must be considered and weighed *before* any court exercises its *final* judgment faculty. To reduce the existing

to look at *all* the relevant facts and evidence before forming any final judgment on this crucial question.

Perhaps the most illuminating statement by this Court came in its comment that whatever value the *Hotchkiss* standard may have had when it was properly employed was in providing a *functional* approach to patentability—not as a mere *label* (383 U. S. at 12). But if the purpose of the *Hotchkiss* standard of "invention" was defeated when it was used as a mere label, the same fate will unavoidably befall the Section 103 standard of "nonobviousness" if *it* is employed as nothing but a label.

The conclusion seems clear that when this Court called for a *factual* inquiry, it meant that *all* the relevant facts—*all* the relevant evidence in the record—must be considered. The courts would only be "out of the frying pan into the fire" if they simply substituted the term "nonobviousness" for the term "invention," and still continued to rely on nothing but an unsupported "hunch," instinct, feeling, or "gut reaction" in deciding whether a given idea rises to the dignity of a validly patentable invention.*

(c) The Most Reliable Evidence Regarding "Nonobviousness" Is the Circumstantial Evidence of the So-Called "Subtests."

Immediately after describing the three-step procedure for applying the Section 103 standard of nonobviousness, the *Graham* opinion cites with approval the discussion of the "sub-

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wide variations in the approach of various courts to the question of patent validity is especially important now that the rule of *Blonder-Tongue Labs.* v. *University Foundation,* 402 U. S. 313, 29 L. Ed. 2d 788 (1971), limits a patentee to a single full and fair hearing on the question of the validity of his patent.

* Judge Giles S. Rich of the United States Court of Customs and Patent Appeals has used even more critical language in characterizing a decisional process that operates without reference to the best factual evidence bearing on patentability, calling it "intuition," "subjective," "personal whims about patentability," and "arbitrary, *a priori* judgments on patentability." G. S. Rich, "Laying the Ghost of the 'Invention' Requirement," 1 APLA Quarterly Journal 26 at 30, 31 and 33 (1972).

tests" of nonobviousness contained in a then recent law review Note, "Subtests of 'Nonobviousness': A Nontechnical Approach to Patent Validity."* That Note presents a powerful case—concerning which this Court expressed *no* qualification or reservation whatsoever—for emphasizing specific *factual* subtests rather than "vague conclusory" standards of invention.** With this approach, the author of the Note pointed out, the courts should be able to reduce the difficulty in applying "the broad standard of nonobviousness." (*Id.* at 1171-1172.)

The high probative value of the circumstantial evidence resulting from use of the subtests of nonobviousness is evident. To paraphrase the author of the Note in question, *factual* evidence as to what *has* and *has not* been done in an attempt to solve the problem to which a given invention is addressed should "constitute a more satisfactory basis for inferring that an innovation is not obvious than either the testimony of adversary experts or the 'judicial hunch' arising from a survey of the prior art by the court" (*id.* at 1180).

The cited Note does not suggest giving *controlling* effect in *every* case to the circumstantial evidence of the subtests it discusses. On the contrary, it states a number of qualifications and *caveats* that must be kept in mind in using the subtests. This Court indicated the same caution, in observing that the subtests "*might* be utilized to give light to the circumstances surrounding the origin of the subject matter" involved, and in pointing out that "As indicia of obviousness or nonobviousness, these inquiries *may* have relevancy" (383 U. S. at 17-18).***

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* Note, 112 U. Pa. L. Rev. 1169 (1964).

** The subjects discussed include (1) longfelt demand, (2) commercial success, (3) commercial acquiescence, (4) simultaneous solution, and (5) professional approval. In particular, the first, second, third and fifth of these subtests are emphasized as often providing evidence of nonobviousness, while the fourth is discussed as often providing the contrary. (*Id.* at 1172-1182.)

*** From the entire context of the Court's opinion, it is clear that its characterization of the subtests of nonobviousness as "*secondary* considerations" does not mean that these considerations have

But nowhere did this Court suggest that these subtests should be applied *only if* a court has not already *intuitively* reached the *a priori* conclusion that an invention is "obvious." On the contrary, in the companion *Cook Chemical Company* cases,* this Court specifically recognized the evidentiary value of the subtests concerning longfelt need and failure of others, when it stated (383 U. S. at 36):

> "These legal inferences or subtests *do focus attention on economic and motivational rather than technical issues* and are, therefore, more susceptible of judicial treatment than are the highly technical facts often present in patent litigation. . . . Such inquiries may lend a helping hand to the judiciary which, as Mr. Justice Frankfurter observed, is most ill-fitted to discharge the technological duties cast upon it by patent legislation. . . . They may also serve to 'guard against slipping into use of hindsight,' . . . and *to resist the temptation to read into the prior art the teachings of the invention in issue.*"

This Court's decision in *Cook* was that in that particular case the "subtest" evidence such as "longfelt need" was not sufficiently compelling to "tip the scales of patentability" when the claimed invention involved "exceedingly small and quite nontechnical mechanical differences," one of which "appears quite plainly on the [prior art] Livingstone device" and the other is "fully disclosed and dedicated to the public in the Livingstone patent" (383 U. S. at 35). Thus, the Court did not *ignore* the "subtest" evidence, but *balanced* it against the other evidence before it. This is very different from what the

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any less probative value, but means simply that they are considerations *beyond* the bare facts of the technology that existed at the time the invention was made. In Judge Rich's article cited in the footnote above, he observes that the Court "could equally have said '*other* considerations' " (p. 39). The use of the word "secondary" was apparently a "rhetorical embellishment" of the kind to which Mr. Justice Clark referred in his discussion in the *Graham* opinion of the now defunct "flash of genius" test (383 U. S. at 15, n. 7).

* *Calmar, Inc.* v. *Cook Chemical Co.* and *Colgate-Palmolive Co.* v. *Cook Chemical Co.*, 383 U. S. 1, 15 L. Ed. 2d 545 (1966).

District Court did here, as affirmed by the Court of Appeals, in Finding of Fact 28.

(d) Further Definition of Graham Doctrine Is Called For.

In the majority of cases passing upon the validity of a patent that have been decided since the *Graham* decision, the various Courts of Appeals appear to have given proper weight to the evidence of the so-called "subtests" of non-obviousness. However, in a significant number of cases in addition to the instant case the evidence of the subtests has been ignored or minimized as being of secondary importance only,* which has resulted in a decision-making process that, as has been shown above, defeats the clear purpose of the *Graham* doctrine. Hence it appears that clarification is called for.

For all the reasons given above, we respectfully submit that this Honorable Court will not only correct an inequitable result in the instant case, but also clarify the decision-making process applicable in future cases of this kind, if it enunciates the following two principles relating to the "subtests of obviousness":

1. In arguing the obviousness or nonobviousness of an invention at the time it was made, counsel shall in every

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* See, for example, *Inject-O-Meter Mfg. Co.* v. *North Plains Fertilizer & Chem., Inc.*, 439 F. 2d 1138, 1142, n. 21 (5th Cir. 1971); *Waldon, Inc.* v. *Alexander Mfg. Co.*, 423 F. 2d 91, 95 (5th Cir. 1970); *Westwood Chemical, Inc.* v. *Owens-Corning Fiberglas Corp.*, 445 F. 2d 911, 918 (6th Cir. 1971); *Scott Paper Company* v. *Fort Howard Paper Company*, 432 F. 2d 1198, 1204 (7th Cir. 1970); *Hadfield* v. *Ryan Equipment Company*, 456 F. 2d 1218, 1221 (8th Cir. 1972); *Exer-Genie, Inc.* v. *McDonald*, 453 F. 2d 132, 136 (9th Cir. 1971); *Bates Industries, Inc.* v. *Daytona Sports Co.*, 441 F. 2d 1110, 1112 (9th Cir. 1971); *Ashcroft* v. *Paper Mate Mfg. Co.*, 434 F. 2d 910, 914 (9th Cir. 1970); *Proler Steel Corporation, Inc.* v. *Luria Brothers & Co., Inc.*, 417 F. 2d 272, 278 (9th Cir. 1969); *Brunswick Corporation* v. *Columbia Industries, Inc.*, 362 F. 2d 172, 175 (9th Cir. 1966).

In the *Scott Paper* case, just cited, the Court of Appeals for the Seventh Circuit said, "We think that even if the trial court failed to consider such factors it would not require reversal" (432 F. 2d at 1204).

case, in order to assist the court, weigh and discuss not only all relevant questions of technology, but also all relevant circumstantial evidence resulting from the application of the so-called "subtests of nonobviousness."

2. The findings of fact made in support of a determination of the obviousness or nonobviousness of an invention shall include not only a discussion of all evidence relating to relevant questions of technology, but also all circumstantial evidence resulting from application of the so-called "subtests of non-obviousness," with proper weight being given to all said evidence according to its probative value.

The suggested propositions of law will emphasize the necessity of considering *all* relevant factual evidence. Specifically, they will make it clear that circumstantial evidence from the "subtests" must in every case be considered and weighed to see whether that evidence—together with the evidence of the related technology—is sufficient, in the language of *Cook*, to "tip the scales of patentability." This will be so whether the *unassisted* initial judicial "hunch" would leave some doubt as to nonobviousness or not.

At the same time, the reference to the "probative value" of the evidence will assure that each item of subtest evidence will be examined critically, and will be given neither more nor less weight than is warranted by all the circumstances, in the light of existing principles governing the drawing of judicial inferences from the evidence in the record in any type of lawsuit, as well as any further legal criteria regarding the question of nonobviousness that may (as suggested by the Reviser's Note to Section 103 of the Patent Act of 1952) later be worked out by the courts (383 U. S. at 16).

Question 2.

The decision of the Court of Appeals on the second question presented for review here is in direct conflict not only with a decision of the Court of Appeals for the Fifth Circuit, but also with two lines of decisions of this Honorable Court.

(a) Conflict with Fifth Circuit.

As pointed out above, the Court of Appeals in the instant case considered it significant that there is a *"single* adjustable brace rod on the exterior" of the bath tub in the illustrative embodiment disclosed in the patent in suit, whereas there are *two* "adjustable slide members on the outside" of the tub in the accused device.

This is surely a distinction without a difference. In addition, the holding of the Seventh Circuit that this fact avoids infringement of the patent in suit is squarely in conflict with the contrary holding of the Court of Appeals for the Fifth Circuit to the effect that to substitute *two* elements for *one* does *not* avoid infringement. *Duo Flex Corp.* v. *Building Service Co.*, 322 F. 2d 94, 99 (5th Cir. 1963).

(b) Conflict with Temco and Prior Supreme Court Decisions.

As also pointed out above, the Court of Appeals for the Seventh Circuit likewise considered it sufficient to avoid infringement of the patent in suit that the patent's illustrative embodiment has a *"flat surface of the housing* on the inside of the tub," while there is a "movable, flexible, *adjustable plate* in the accused device, which is on the inside of the tub."

This is another distinction without a difference. Moreover, the holding of the Court below is in direct conflict with a holding of this Honorable Court, for if making the stabilizing means more adjustable constitutes an improvement over the disclosed illustrative embodiment—as indeed it may—this still does not avoid infringement. As this Court said in *Temco Electric Motor Co.* v. *Apco Mfg. Co.*, 275 U. S. 319, 328, 72 L. Ed. 298 (1928):

> "It is well established that an improver can not appropriate the basic patent of another and that the improver without a license is an infringer and may be sued as such." (Citing, among other cases, *Cochrane* v. *Deener*, 94 U. S. 780,

787, 24 L. Ed. 139 (1877) and *Cantrell* v. *Wallick*, 117 U. S. 689, [695], 29 L. Ed. 1017 (1886).)

(c) Conflict with Equitable Doctrine of Equivalents.

The equitable doctrine of equivalents originated more than a century ago in the case of *Winans* v. *Denmead*, 56 U. S. (15 How.) 330, 14 L. Ed. 717 (1853), and has been applied since then in a long line of decisions by this and other Courts. It evolved, as this Court pointed out in *Graver Tank Co.* v. *Linde Air Products Co.*, 339 U. S. 605, 94 L. Ed. 1097 (1949, reh. 1950), from a recognition of the fact that "to permit imitation of a patented invention which does not copy *every literal detail* would be to convert the protection of the patent grant into *a hollow and useless thing*" (339 U. S. at 607). As the Court further observed, "The essence of the doctrine is that one may not practice a fraud on a patent" (339 U. S. at 608).

To hold, as the District Court and Court of Appeals did here, that infringement of the patent in suit was avoided merely by substituting two elements for one, and by making still another element adjustable, makes this patent "a hollow and useless thing." Neither these changes nor the "different weight transfers" testified to by defendants' witness Mr. Kellogg and referred to by the Court of Appeals (page A6, below), can have any real significance. The minor differences in the functioning of the stabilizing means of the patentee's illustrative embodiment and the stabilizing means of the accused device are nothing but differences in degree. The two means are equivalent.

To hold otherwise clearly does violence to the century-old equitable doctrine of "equivalents." And neither the defendants below nor the Court of Appeals in its opinion have cited any authority to support the view that the term "equivalent" as used by the Congress in Section 112 of the Patent Act of 1952 should be given a narrower meaning than it has in the equitable doctrine of equivalents.

The stabilizing means in the accused device is clearly the equivalent of the stabilizing means disclosed in the patent in suit, and the accused device thus infringes the claims of the patent.

VII.

CONCLUSION.

Petitioner respectfully submits:

1. There is no question more fundamental to the patent system, or more important to inventors and patentees, than the question of how a court shall determine whether or not a given invention was "obvious" to those skilled in the art at the time the invention was made. It is important that such determinations be made under the rule of *Graham* v. *John Deere Co.* only *after* consideration of all the relevant factual evidence, so as not to turn on mere judicial "hunches" or intuition.

2. If the full import of the doctrine of the *Graham* case is delineated by further judicial interpretation, the objectives of this Court in enunciating the doctrine will not be defeated in the future as the decisions below would do here. Specifically, a more detailed description of the process of inquiry involved in the three-step procedure mandated by *Graham* would help guide patent counsel in the preparation of briefs, and assist the courts in future judicial determinations of questions of alleged "obviousness."

3. The instant case is an especially good one for further examination of the *Graham* doctrine because the invention of the patent in suit is admittedly a simple mechanical invention whose nonobviousness can be established most convincingly by application of certain of the "subtests" of nonobviousness, and there are in the record uncontroverted facts bearing on these subtests.

4. With regard to the infringement aspect of the instant case, the meaning assigned by the Court of Appeals to the

term "equivalents" (a) would deprive this patentee of the important protection of the equitable doctrine of "equivalents," which has been applied by the courts since its first expression in 1853 in the case of *Winans* v. *Denmead*, 56 U. S. (15 How.) 330, 14 L. Ed. 717, and (b) unduly limits the interpretation of Section 112 of the Patent Act of 1952.

For all these reasons, we respectfully request that a writ of certiorari issue in this case.

Respectfully submitted,

JAMES W. CLEMENT,
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Chicago, Illinois 60601,
Attorney for Petitioner.

APPENDIX.

IN THE UNITED STATES COURT OF APPEALS
For the Seventh Circuit

Nos. 72-1482 and 72-1483 (Consolidated)
September Term, 1972

Before SWYGERT, *Chief Judge*, KNOCH, *Senior Circuit Judge*, and KILEY, *Circuit Judge*.

Silvestri Corporation,
Plaintiff-Appellant,

vs.

Marshall Field & Co., J. C. Penny Co., Inc. and Co-Op Electric Supply Co.,
Defendants-Appellees.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

ORDER

Boulevard Electronics, Inc., not a party to this appeal, filed its suit in the United States District Court, charging the defendants-appellees, Marshall Field & Co., J. C. Penney Co., Inc. and Co-Op Electric Supply Co., with infringement of its patent No. 3,292,615 issued December 20, 1966, "Device for Agitating, Swirling and Aerating the Water in a Vessel, such as in a Bath Tub or the Like," by their sale of a whirlpool bath device bearing the trade mark "Turbo-Jet." The District Judge, after trial, held the patent invalid and dismissed the complaint with prejudice. After direction to enter judgment for the defendants, from which an appeal was taken, but prior to entry of findings of fact,

conclusions of law, and final judgment, from which a supplemental appeal was taken (later consolidated by this Court) the present plaintiff-appellant, Silvestri Corporation, was substituted as party-plaintiff.

Of the 36 findings of fact entered by the District Judge, plaintiff sees 23 as significant and characterizes 19 of those as clearly erroneous. We do not agree.

Plaintiff contends that the District Judge misdescribed the invention by omitting salient features of it; failed to note the most pertinent features of the prior art; attributed significance to prior art not before the Patent Office although that prior art, in the opinion of the plaintiff, was less pertinent than the prior art examined and rejected by the Examiner; considered irrelevant prior art; incorrectly found the invention obvious to one having ordinary skill in the field; overlooked a long felt need satisfied by this invention; and improperly placed the burden of proving validity upon the plaintiff.

Plaintiff further argues that the District Court erred in unduly limiting the scope of the claims and so narrowly interpreted them as to hold that the accused device sold by the defendants would not infringe the patent were it valid.

If the findings of fact numbered 7 through 13 are read as a whole, as we believe they should be, they fully describe the subject of the patent, including the specific features to which plaintiff refers, of the housing with an undersurface capable of resting directly on, and of being securely supported on, the top surface of the wall of a conventional bathtub, capable of accommodating to a bathtub wall of any thickness, and of being used with tubs of differing heights and widths.

Although plaintiff complains of the District Court's descriptions of the prior art, we find them sufficiently clear. It was not necessary for the Court to compare in detail each item of the prior art with the claimed invention. Some of the prior art to which the Court refers, including items which were apparently not before the Patent Examiner, appear in the record as plain-

tiff's exhibits, e.g. the "Hydro-bath" and the "Aqua-Spa." The patent drawings and descriptions of the prior art in the record are abundantly clear and easily followed. The District Court noted, as the exhibits show, that both of these devices which were not before the Patent Examiner show an electrical power unit outside the tub and mounted on the tub walls to fit any tub. Plaintiff argues that the District Judge does not state that failure of the supporting legs of the Hydro-bath, which rest on both walls of the tub, might allow the descent of the motor into the water with fatal results and that, as indicated, it is mounted on both walls whereas plaintiff's device is mounted on only one wall. Plaintiff further disputes the District Judge's description of the Aqua-Spa as "mounted" because of its two portions, the motor rests on the floor of the bathroom and the pump is secured at the bottom of the tub to the inside of the tub wall, with the two connected by a flexible cable passing over the tub wall.

The "Handi-Whirl," which was not before the Patent Examiner is part of the prior art, as well. Plaintiff here, too, feels that the District Judge did not adequately describe the device in his findings to show that when its inverted U-shaped housing straddles the tub wall, the undersurface of the U does not necessarily touch the top of the tub wall and that the device is supported by contact of the outside "leg" with the floor and the inside "leg" with the bottom of the tub. F. C. Bascomb, the inventor of plaintiff's device, testified that in a very low tub, of a depth less than the height of the device's "legs," the plaintiff's device would also rest on the floor of the bathroom and the tub bottom.

In every case, the drawings and photographs in evidence are clear and from our reading of the findings of fact as a whole, we are satisfied that the Trial Judge did not, as plaintiff fears, misconstrue the prior art.

The above noted differences between the plaintiff's device and the prior art do not destroy the character of these inventions as pertinent prior art. Nor can we agree that this prior art was

less pertinent than that considered by the Patent Examiner. The Podell patent was before the Examiner, but, lacking such prior art as the Handi-Whirl and Essick, Podell's teachings could not have been fully evaluated. The Schroeter patents, also cited by the Examiner, both provide for support only on the floor outside the tub, unlike Handi-Whirl which is supported on both sides of the tub wall and stabilized inside and outside the tub. The same observation applies to the District Court's taking note of other uses of the expedient of hanging a device on the top of a wall and adjusting screws to accommodate varying thickness of wall, with a screw leveling brace where the heavier part is on one side, as in outboard motors on boats or trays and speakers on automobile doors in drive-in restaurants and theatres. The Court was not limited to consideration of bathtub devices.

Plaintiff places great weight on the Order, entered prior to the findings of fact and conclusions of law, in which the Court directed judgment for defendants on the ground that the plaintiff failed to establish an invention justifying the patent in suit. Plaintiff complains that the Court ignored the presumption of validity and improperly imposed the defendants' burden on the plaintiff. However, in this case, the statutory presumption of validity was destroyed when it became apparent that much of the pertinent prior art was not considered by the Patent Examiner. *Hobbs* v. *Wisconsin Power & Light Co.*, 7 Cir., 1957, 250 F. 2d 100, 105, *cert. den.* 356 U. S. 932; *Simmons Co.* v. *Hill-Rom Co.*, 7 Cir., 1965, 352 F. 2d 886, 888; *T. P. Laboratories, Inc.* v. *Huge*, 7 Cir., 1966, 371 F. 2d 231, 234.

Contrary to plaintiff's contentions, our reading of the record satisfies us that the Trial Judge did apply the proper standards in holding that the subject matter of the alleged invention, while performing a useful and commercially successful function, would have been obvious at the time to one having ordinary skill in the art. *Graham* v. *Deere Co.*, 1966, 383 U. S. 1, 17; *Anderson's Black Rock* v. *Pavement Salvage Co., Inc.*, 1969, 396 U. S. 57, 60; *Gass* v. *Montgomery Ward & Co.*, 7 Cir., 1967,

387 F. 2d 129, 130. He determined the scope and content of the prior art, ascertained the differences between it and the claims, and the level of skill at the time. Plaintiff would have us require more detailed exposition of these functions in the findings, but it is clear to us that the Trial Judge was not derelict in the performance of his duties. He found ordinary mechanical principles were employed which would be familiar to a worker in the art so that such differences as did exist between the claims and the prior art would have been obvious at that time to one skilled in mechanical and electrical appliance art.

The record does not support a conclusion that the commercial success of plaintiff's device is attributable to features disclosed in the claims, rather than to skilled marketing practices, including extensive advertising. See *A & P Tea Co.* v. *Supermarket Corp.*, 1950, 349 U. S. 147, 153. Besides, the commercial units have adjustable stabilizing bumpers on both inside and outside of the tub wall with two leveling bumpers on one side, although the patent shows only one. Similarly, the patent does not refer to the material of which the casing is made, but Mr. Bascomb agreed that approval by Underwriters Laboratories has a significant effect on marketability and the casing is made of plastic to secure such approval and to provide safety for the user. These features may contribute markedly to commercial success of the item.

We have studied the claims in connection with plaintiff's argument that the District Judge too narrowly limited their scope to the specific illustration in the specifications and drawing when he held that, even if valid, the patent was not infringed. For example, claim one includes "means" adapted to engage the exterior and interior sides of the bathtub wall so that the device when resting on the top ledge surface of the bathtub wall engages it along the top ledge surface and exterior and interior sides of the tub wall firmly to support the device while in operation. Tom Kellogg, the industrial designer of the accused device, testified to using two members at the bottom of the

large part of the casing, resting against the outside surface of the tub and a plate resting against the inside. Plaintiff contends that this falls within the scope of the claimed "means," as these members are used to combat torque from the weight of the motor and the result of the pump operating in the water. "Means" here cannot be interpreted to cover every possible way but only in accordance with the provisions of Title 35 U. S. C. § 112, which provides for construing a claim for a combination in which an element is expressed as a "means" or step for performing a specified function, to cover the corresponding structure or acts described in the specification and equivalents thereof. There must be real identity of means, operation and result; a device changed in principle and achieving the same result by a different mode of operation is not an equivalent or an infringement of the claim even if it falls within the literal wording of the claim. *Independent Pneumatic Tool Co.* v. *Chicago Pneumatic Tool Co.*, 7 Cir., 1952, 194 F. 2d 945, 947.

The plaintiff's patent specifications describe a single adjustable brace rod on the exterior and the flat surface of the housing on the inside of the tub. There is no disclosure of the defendants' movable, flexible, adjustable plate in the accused device, which is on the inside of the tub, to co-operate with the adjustable slide members on the outside, to clamp the device onto the tub. Mr. Kellogg, whose testimony the Trial Judge obviously credited, testified that different weight transfers take place in the accused device to provide as little pressure on top as possible to accommodate aluminum rails.

We have considered all other arguments advanced by the appellant in the light of the cases and authorities cited. However, as our own view of the record shows substantial support in the evidence for the District Court's findings of fact, they may not be set aside. *Wahl* v. *Carrier Mfg. Co.*, 7 Cir., 1966, 358 F. 2d 1, 3. The judgment of the District Court is affirmed.

IN THE UNITED STATES COURT OF APPEALS
For the Seventh Circuit

Nos. 72-1482 & 72-1483.
(Consolidated)
September Term, 1972

SILVESTRI CORPORATION,
Plaintiff-Appellant,

vs.

MARSHALL FIELD & CO., et al.,
Defendants-Appellees.

December 20, 1973.

Before SWYGERT, *Chief Judge*, KNOCH, *Senior Circuit Judge*, and KILEY, *Circuit Judge*.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION. (67 C 1170)

On consideration of the petition for rehearing and suggestion that it be reheard *en banc* filed in the above-entitled causes, no judge in active service having requested a vote thereon, nor any judge having voted to grant the suggestion, and all of the members of the panel having voted to deny a rehearing,

IT IS ORDERED that the petition for a rehearing in the above-entitled causes be and the same is hereby denied.

IN THE UNITED STATES DISTRICT COURT
Northern District of Illinois
Eastern Division

BOULEVARD ELECTRONICS, INC.,
Plaintiff,
vs.
MARSHALL FIELD & COMPANY, J. C. PENNEY CO., INC., AND CO-OP ELECTRIC SUPPLY CO.,
Defendants.

Civil Action
No. 67 C 1170.

FINDINGS OF FACT.

1. Plaintiff, Boulevard Electronics, Inc., is a corporation of the State of Illinois and has its principal office at Chicago, Illinois.

2. Defendants, Marshall Field & Co., J. C. Penney Co., Inc. and Co-op Electric Supply Co., all have regular and established places of business in Chicago, Illinois.

3. The complaint herein was filed July 7, 1967, charging defendants with patent infringement by reason of their sale of a whirlpool bath unit intended for use in a conventional bath tub. The units sold by defendants were marketed under the trademark "TURBO-JET".

4. On December 20, 1966, Letters Patent No. 3,292,615 entitled "DEVICE FOR AGITATING, SWIRLING AND AERATING THE WATER IN A VESSEL, SUCH AS A BATHTUB OR THE LIKE", issued to Plaintiff as a result of assignment from the applicants, Frank C. Bascomb and Erna Mayer. Plaintiff is now the owner of said Letters Patent, and is entitled to maintain this action.

5. Plaintiff, Boulevard Electronics, is owned entirely by Frank C. Bascomb and his wife, Mrs. Bascomb (formerly Erna Mayer), the inventors named in the patent in suit.

6. The TURBO-JET unit sold by the defendants was manufactured by The Songrand Corporation. The Songrand Corporation is not a party to the suit.

7. The subject matter of the patent in suit is, in essence, an electrically-driven pump which can be placed on the wall of a conventional domestic bathtub, and which serves to generate a swirling and turbulent action of the water in the tub. The main component is a housing or casing in the general shape of an inverted U. It is intended to be placed over the wall of the tub with one "leg" of the U inside the tub and the other "leg" outside. The "legs" and the portion which connects them to complete the U shape are hollow.

8. The "leg" outside the tub contains an electric motor which has an upwardly extending drive shaft with a pulley at its upper end. The "leg" inside the tub has a centrifugal pump at its lower end. In operation the pump is submerged in the water in the tub. The impeller of the pump is mounted on a shaft extending upwardly within the inside "leg". A pulley is on the upper end of that shaft. An endless V-belt extends through the hollow portion of the housing overlying the tub wall, and connects the motor pulley and pump pulley. When the motor is turned on, the pump circulates the water in the tub.

9. The device described in the patent is described as capable of being used with tubs of differing height and width. In order to accomodate the differing widths, and to insure that it will be firmly braced and supported during operation, the patentees provided a horizontal bracing rod screwed into the outside "leg" of the housing. This rod has a rubber pad at its outer end for engaging the exterior tub wall surface; it can be screwed in or out in order to make the device fit to the particular tub on which it is placed.

10. While not a feature of the patent as it was finally issued, the device shown in the drawings and described in the specification also provided for inducing and mixing air into the water discharged from the pump.

11. The objectives which the inventors considered their development to serve are stated in the opening paragraphs of the patent. According to the patentees, the objectives of the "invention" were to provide a device

> ". . . which is of a portable nature and which may be readily positioned on a bathtub or like vessel for agitating and aerating the water in a bathtub, and wherein the electrically operated means for operating the agitating means are disposed exteriorly of the bathtub so that at no time is the electrically operated means or any of the electrical connections associated with the water."
>
> ". . . for swirling and aerating the water in a vessel, such as a bathtub or the like, in which the electrical operated means for operating the device is disposed exteriorly of the bathtub to eliminate the possibility of any water coming into contact with the electrical components. The device is very portable, and may be readily positioned on a bathtub and may be readily removed therefrom when not in use."
>
> ". . . which will provide swirling, bubbling and aerated water in the bathtub, which device is electrically operated but in which the electrical components are positioned exteriorly of the water and remote from the water, to provide a unit which is safe and in which all hazards attendant the use of electrically operated means which are associated with water are completely eliminated."

12. The patent contains six claims. Plaintiff asserts that the "TURBO-JET" unit sold by defendants comes within the scope of, and therefore infringes, claims 1, 2, 3, 4 and 6. Claim 1 is the only independent claim. Claims 2, 3, 4 and 6 are dependent upon, and somewhat narrower in scope than, claim 1.

13. Claim 1 is very much a word picture of the device as described and illustrated in the patent. Thus it calls for the housing with what have been termed the two "legs" and a central portion between them. The central portion is defined as having an undersurface adapted to be positioned to rest on the top ledge surface of one of the bathtub walls; the central portion is also defined as of a width so that it can be accomo-

dated on a bathtub wall of any thickness. The claim includes a reference to means adapted to engage the exterior and interior sides of the tub wall to support the device while in operation. The claim further calls for an electric motor in the "leg" of the housing outside the tub, a pump supported by the inside "leg" and a "means" (exemplified by the V-belt) extending through the central portion of the housing and connecting the motor and pump so that the latter is operated by the former to agitate the water in the tub.

14. Claims 2 and 3 add to claim 1 the feature of adjustability to the wall engaging means and the location of the adjustable support at a low point on the outside housing.

15. Claim 4 recites the portability of the unit and the formation of the undersurface of the central portion as being substantially flat.

16. Claim 6 calls for an arrangement in which that portion of the unit located outside the tub is heavier than the portion of the unit located inside the tub.

17. The Plaintiff has established no specific date earlier than the filing date of the application for patent for completion of the invention. December 26, 1963 therefore constitutes the earliest date which plaintiff can rely on for completion of the alleged invention.

18. Prior to December 26, 1963 there was commercially available to the public a home bathtub unit sold under the name "AQUA-SPA". This unit consisted of an electric motor mounted in a casing placed outside the tub. The motor was connected with a flexible cable, like a speedometer cable, which passed over the wall of the tub and connected with and drove a pump submerged in the tub.

19. Another publically available prior art unit on sale prior to the alleged date of invention was a unit known as the "HYDRO-BATH" unit. This unit was supported on the walls of the tub with the motor above the water and the pump below the water.

20. The patentees were aware of the existence of the "AQUA-SPA" and "HYDRO-BATH" units at the time of filing their patent application. There is no evidence establishing that the Patent Examiner was aware of these devices at the time of his consideration of the application for patent in suit. Yet to the extent that they illustrated positioning the electrical power unit outside the tub and the mounting of the unit on the tub walls, so it would fit any tub height, the prior art units heretofore adverted to were directly pertinent to the matter to be decided by the Examiner.

21. As early as 1961 there was also being offered for sale and sold a home bathtub whirlpool unit under the name "HANDI-WHIRL". It was advertised in a publication entitled *Rental Service Forecaster* for July, 1961. The HANDI-WHIRL unit is shown in U. S. Design Letters Patent No. 196,020, issued August 13, 1963 on an application filed October 27, 1961. The latter patent was not cited or relied on by the Examiner in the Patent Office, nor is there any evidence that he was aware of it or of the HANDI-WHIRL unit advertised and sold prior to December 26, 1963.

22. The "HANDI-WHIRL" unit is, in all aspects save one, quite similar in structure and operation to the device disclosed in the patent in suit. Its main component is a plastic housing of inverted U-shape, with hollow "legs" connected by a hollow central portion. It was intended to be and was in fact used by placing it over the wall of the tub. An electric motor is located in the "leg" outside the tub. A centrifugal pump is located at the bottom of the "leg" inside the tub. Both motor and pump have upwardly extending shafts with pulleys and the pulleys are connected by a V-belt which extends through the central portion between the two "legs".

23. The only appreciable mechanical difference between the "HANDI-WHIRL" unit and the subject matter of claim 1 of the patent in suit is that patented structure is designed to be hung on the tub wall whereas the "HANDI-WHIRL" unit is normally intended to straddle the tub wall.

24. The expedient of hanging a mechanical device on the top of a wall is one that was utilized in many fields prior to the date of alleged invention of the patent in suit. It was even done with whirlpool bath units, as exemplified by another item of prior art, Rocke patent 2,272,585, issued February 10, 1942. Other examples are the mounting of outboard motors on the transom of a boat, the hanging of drive-in restaurant trays and speakers for drive-in movies on automobile windows and the supporting of air conditioning units on window ledges with parts engaging both the inside and outside wall surfaces. The latter, along with the use of adjusting screws to accommodate walls of varying thickness is shown in Essick patent 2,380,586, issued July 31, 1945 and in Podell patent 2,376,722, issued May 22, 1945, both of which are also a part of the prior art.

25. The level of ordinary skill in the art of developing whirlpool bath units was at the time of the alleged invention of the patent in suit that involved in design of mechanical and electrical appliances. Ordinary mechanical principles were employed, and one would have expected a worker in this art at that time to be fully familiar with basic mechanical concepts of weight and balance, leverage and the like employed in many different fields of use.

26. Such differences as there are between the subject matter of the claims of the patent in suit and the prior art are such that the subject matter of the claims as a whole would have been obvious at the time of the alleged invention by one skilled in the mechanical and electrical appliance art.

27. Plaintiff has urged that the commercial success of the unit sold by it under the mark "HYDRO-JET" is sufficient to establish non-obviousness. However, assuming (without deciding) that there has been such success, it has not been established that such success was due to the features set forth in the claims of the patent.

28. Under the circumstances of this case, it is unnecessary to consider the subtests of non-obviousness, such as long-felt

need, commercial success, etc., because it is clear from the prior art that the patent in suit would have been obvious to a person having ordinary skill in the art.

29. Claims 1, 2, 3, 4 and 6 of the patent in suit are invalid under 35 USC 103 because the alleged invention was obvious to a person of ordinary skill in the art in view of the prior art.

30. An invalid patent, of course, cannot be infringed. Since plaintiff may wish to appeal this Court's decision, however, it is necessary for the Court to rule on the question of whether plaintiff's patent—if valid—is infringed by the TURBO-JET unit.

31. The minimal distinctions between the patent in suit and the prior art require that the claims of the patent be given a narrow interpretation.

32. The specification of the patent in suit describes only one specific form of means adapted to engage the exterior and interior side of the bathtub walls to firmly support the device while in operation. This consists of a shoulder or face on the inside "leg" and the adjustable rod attached to the outside motor housing.

33. In the TURBO-JET unit, the holding force on the side walls of the tub is developed by a movable and flexible plate which is mounted on the underside of the central crossover portion located above the tub wall. It is adjustable to engage the inside of the tub wall and cooperates with adjustable slide members on the outside to clamp the unit to the tub. Nothing is disclosed in the patent that is in any way like the adjustable plate of the TURBO-JET unit.

34. The provision of the adjustable plate structure is an important part of the TURBO-JET mounting system. It is used in order to assure that the motor housing is always located as closely as possible to the tub wall, and also to provide a means of distributing the weight to a number of points.

35. The distinction between the means for engaging the exterior and interior sides of the bathtub wall in the patent in

suit and that used in the TURBO-JET unit is significant enough so that the TURBO-JET unit does not infringe the patent in suit.

36. The wall engaging means of the TURBO-JET unit is not the mechanical equivalent of the means of the patent in suit.

CONCLUSIONS OF LAW

1. The prior art Design Patent 196,020, Essick Patent 2,380,586, and AQUA-SPA, HYDRO-BATH, and HANDI-WHIRL water agitators were not cited by nor relied upon by the United States Patent Office during the prosecution of the application for the patent in suit, and consequently, there is no presumption of validity as to this prior art.

2. Defendants have satisfied their burden of proof in establishing the invalidity of claims 1, 2, 3, 4 and 6 of the patent in suit.

3. Under 35, U. S. C. Section 103, the Court concludes as a matter of law, that the differences between the subject matter sought to be patented in claims 1, 2, 3, 4 and 6 of the patent in suit and the prior art are such that the subject matter as a whole would have been obvious at the time the alleged invention was made to a person having ordinary skill in the art to which said subject matter pertains and, therefore, said claims are invalid.

4. The TURBO-JET units sold by the defendants do not infringe any claim of the patent in suit.

/s/ JAMES B. PARSONS
United States District Judge

February 22, 1972